

**REMARKS**

This communication is responsive to the Official Action mailed March 9, 2004, finally rejecting all the claims then pending in the application, namely claims 7-24.

Applicant notes with appreciation the telephonic interview of May 18, 2004 between the Examiner and the undersigned.

Claim 7 has been amended to recite "providing an intermediate element including a plurality of substantially solid elongated ferromagnetic rods extending side-by-side in a lengthwise direction and with a dielectric material therebetween." Applicant respectfully submits that the amendment to claim 7 does not constitute the addition of new matter. Support for this amendment may be found, for example, by reference to FIG. 1B and the accompanying description thereof. Applicant also respectfully submits that the amendment to claim 7 is meant to clarify the claimed subject matter of claim 7 in accordance with the interview of May 18, 2004.

Applicant has also amended claims 10, 11 and 19 to improve their form as is indicated hereinabove.

Claims 33 through 44 are presented for the first time. Applicant respectfully requests consideration and allowance of these claims. As is set forth below in further detail, applicant respectfully submits that newly presented claims 33 through 44 do not constitute the addition of new matter.

In particular, in addition to reciting limitations (a) and (b) as set forth in original claim 7, claim 33 also recites "assembling a plurality of the shim pieces on a pole of the magnetic resonance imaging magnet to form a shim on the pole." Applicant respectfully submits that the step of assembling of claim 33 was essentially recited in original claim 8. As such, newly presented claim 33 is drawn to the claimed subject matter

of original claim 8.

Newly presented claims 34, 35 and 36 essentially recite the claimed subject matter of original claims 9, 10 and 11, respectively. As such, applicant respectfully submits that newly presented claims 34, 35 and 36 do not constitute the addition of new matter.

Newly presented claims 37, 38 and 39 essentially recite the claimed subject matter of original claims 14, 15 and 16, respectively. As such, applicant respectfully submits that newly presented claims 37, 38 and 39 do not constitute the addition of new matter.

Newly presented claim 40 essentially recites the claimed subject matter of original claim 19 and therefore, applicant respectfully submits that newly presented claim 40 does not constitute the addition of new matter.

Newly presented claims 41, 42, 43 and 44 essentially recite the claimed subject matter of original claims 20, 22, 23 and 24, respectively. Accordingly, applicant respectfully submits that newly presented claims 41 through 44 also do not constitute the addition of new matter.

In addition, newly presented claims 34 through 44 either directly or indirectly depend from newly presented claim 33.

In the Official Action of March 9, 2004, claims 7-12, 14 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,813,767 to *Sasaki* et al. (hereinafter "*Sasaki*"). Claims 13, 15-18 and 20-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sasaki* in view of U.S. Patent No. 3,849,878 to *Rudd* et al. (hereinafter "*Rudd*").

In rejecting claim 7 the Examiner asserts that "*Sasaki* discloses a method of making pieces comprising: providing an intermediate element (in Fig. 1a) including a plurality of

ferromagnetic rods 11 with a dielectric material (molding material 12) therebetween." (Official Action, pg. 2.) Claim 7 has been amended to now recite "providing an intermediate element including a plurality of substantially solid elongated ferromagnetic rods extending side-by-side in a lengthwise direction with a dielectric material therebetween." In view of the present amendment to claim 7 and the telephonic interview of May 18, 2004, applicant respectfully submits that the foregoing rejection of claim 7 as anticipated by *Sasaki* is now moot. *Sasaki* discloses a method for manufacturing an individual magnetic thin film core and explicitly teaches that the magnetic thin film is provided as a cover on a core wire 15. (*Sasaki*, col. 7, lns. 3-8.) More particularly, the "magnetic material is preferably applied as a thin which is illustrated in greatly exaggerated dimensions in the FIGS. for the purposes of illustration." (Id. col. 3, lns. 30-32.) In this regard, core wires covered by a thin layer of magnetic material are of course not identical to a "plurality of substantially solid elongated ferromagnetic rods" as is now recited in claim 7. Indeed, *Sasaki*'s intermediate <sup>non-magnetic</sup> element includes only a "magnetic thin film" that <sup>surrounds a core wire</sup> ~~is substantially hollow~~.

In addition, *Rudd* does not make up for the deficiencies in *Sasaki* and therefore the combination of *Rudd* and *Sasaki* cannot be used to obviate claim 7 or any other claim currently pending in the application. Indeed, the cores 24 of *Rudd*'s block 26 comprise "a magnetic wire core 12 such as of a copper wire." (*Rudd*, col. 2, lns. 13-16 and col. 2, lns. 65 to col. 3, ln. 1; see also col. 3, lns. 28-32 and col. 1, lns. 10-12.) Further, in this regard, *Rudd* teaches the manufacture of multiple electric elements by winding a wire on core 12, placing these cores in a block of plastic material 26 and performing various other operations, including slicing the block to produce the electrical elements. (Id., col. 2, ln. 65

to col. 3, ln. 24.) *Rudd* however does not disclose, teach or suggest the use of ferromagnetic rods. As such, *Rudd* does not make up for the deficiencies of *Sasaki*.

In the Official Action the Examiner also rejected claim 8 by asserting that "*Sasaki* further teaches assembling the shim pieces with a magnet pole, i.e., closed magnetic circuit (at col. 2, lines 46-49)." (Official Action, pg. 3.) Applicant respectfully submits that *Sasaki's* disclosure of "forming a closed magnetic circuit on the pole wire by utilizing a metal magnetic material" is not identical to or suggestive of "assembling a plurality of the shim pieces on a pole of the magnetic resonance imaging magnet to form a shim on the pole," as is recited in newly presented claim 33. Indeed, forming a closed magnetic circuit on a core wire is not remotely suggestive of forming a shim on a pole of a magnetic resonance imaging magnet. As such, *Sasaki* does not anticipate newly presented claim 33 for at least this reason. In addition, as *Rudd* is concerned with making a resistance element, *Rudd* does not suggest "assembling a plurality of the shim pieces onto a pole of the magnetic resonance imaging magnet to form a shim on the pole," as is recited in claim 33. As such, *Sasaki* and *Rudd* cannot be combined to obviate claim 33 as neither reference discloses or suggests a limitation recited in the claim.

Applicant therefore respectfully submits that *Sasaki* does not anticipate claims 7 and 33 or any other claim currently pending in the application for at least the reasons provided above. In addition, the combination of *Sasaki* and *Rudd* do not provide a basis for obviating any of the claims currently pending in the application as neither reference makes up for the deficiency in the other. As such, applicant respectfully submits that claims 7 and 33 are allowable. Furthermore, as all the other claims in the application, namely claims 8-24 and 34-44, either directly or indirectly depend from claim 7 or claim

33, respectively, applicant also respectfully submits that these claims are also allowable for at least the reasons provided above.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding final rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 27, 2004

Respectfully submitted,

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